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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,674	06/05/2006	Shunpei Yamazaki	0756-7719	6916
31780	7590	03/05/2008	EXAMINER	
ERIC ROBINSON			COLEMAN, WILLIAM D	
PMB 955			ART UNIT	
21010 SOUTHBANK ST.			PAPER NUMBER	
POTOMAC FALLS, VA 20165			2823	
			MAIL DATE	DELIVERY MODE
			03/05/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,674	Applicant(s) YAMAZAKI ET AL.	
	Examiner W. David Coleman	Art Unit 2823	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-17, 19, 20, 22-26 and 28-30 is/are rejected.
- 7) ☒ Claim(s) 10, 18, 21 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. Claims 1-9, 11-17 and 19-20 of this application conflict with claims 1-19 of Application No. 11/007,645. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. The term "heat-resistant" in claim s 23, 24, 27 and 29 is a relative term which renders the claim indefinite. The term "heat-resistant" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. An appropriate range of temperatures will provide some direction as to what Applicants are claiming because all materials have a boiling point, melting point and freezing point. A temperature that may cause one material to boil can possibly be the freezing temperature of another material.

Claim Rejections - 35 USC § 102

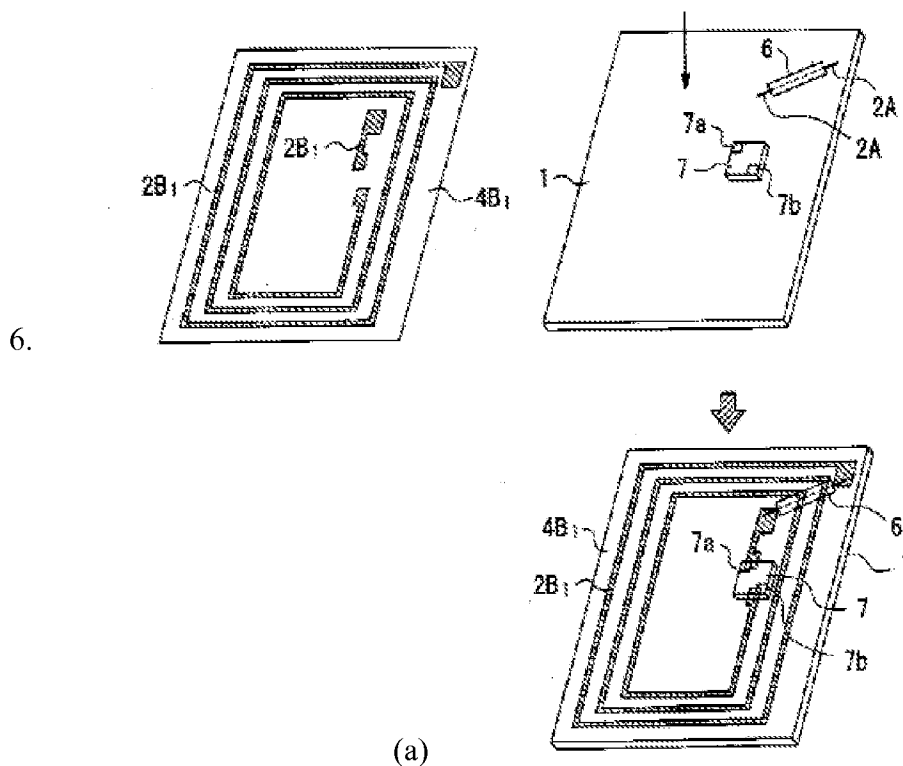
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 23-30 are rejected under 35 U.S.C. 102(e) as being anticipated by

Hashimoto U.S. Patent Application Publication No. 2004/0016115 A1.



7. Pertaining to claim 23, Hashimoto teaches a noncontact thin film integrated circuit device comprising:
- a thin film integrated circuit **7** formed over a substrate **1** with a base film **4B** interposed therebetween;

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a heat-resistant insulating film formed over the thin film integrated circuit (please note that integrated circuit has contacts 7a and 7b, the material between the contacts is well known to be insulating so as to not short circuit the integrated circuit) and an antenna formed over or under the thin film integrated circuit **2B₁**.

8. Pertaining to claim 24, Hashimoto teaches a noncontact thin film integrated circuit device comprising:

a thin film integrated circuit formed over a substrate with a base film interposed therebetween; and

a heat-resistant insulating film formed over the thin film integrated circuit;

a substrate provided with an antenna,

wherein the thin film integrated circuit is enfolded with the substrate and connected to the antenna.

9. Pertaining to claim 25, Hashimoto teaches a noncontact thin film integrated circuit device according to claims 23 or 24, wherein the antenna contains an element selected from the group consisting of Ag, Au, Al, Cu, Zn, Sn, Ni, Cr, Fe, Co and Ti (in this case, Hashimoto teaches an antenna comprising of silver, Ag, see paragraph [0051]).

10. Pertaining to claim 26, Hashimoto teaches a noncontact thin film integrated circuit device according to claim 23 or 24, wherein the substrate is flexible (please note that all materials are flexible relative to some ideal temperature, please note that

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Hashimoto teaches a plastic substrate in the background of the invention , see paragraph [0004]).

11. Pertaining to claim 28, Hashimoto teaches a noncontact ID tag including a noncontact thin film integrated circuit device according to claim 23 or claim 24.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto U.S. Patent Application Publication No. 2004/0016115 A1 in view of Kawai et al., U.S. Patent 6,621,153.

Hashimoto teaches a semiconductor device substantially as claimed.

Pertaining to claim 29, Hashimoto fails to teach a coin comprising a noncontact thin film integrated circuit device, the noncontact thin film integrated circuit formed over a substrate with a base film interposed therebetween;

a heat-resistant film formed over the thin film integrated circuit; and

an antenna formed over or under the plurality of thin film integrated circuit.

Specifically, Hashimoto fails to teach wherein a part of the component such as the antenna functions in a coin. Kawai teaches that an IC tag can function in a coin. In view of Kawai, it would have been obvious to one of ordinary skill in the art to incorporate the

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use of the semiconductor device of Kawai into the Hashimoto invention because it can be used as a substitute for money (see paragraph [0001] of Kwai).

14. Pertaining to claim 30, the combined teachings of Hashimoto and Kwai teach a coin according to claim 29, wherein a material for the antenna or a component composing the coin contains an element selected from the group consisting of Ag, Au, Al, Cu, Zn, Sn, Ni, Cr, Fe, Co and Ti.

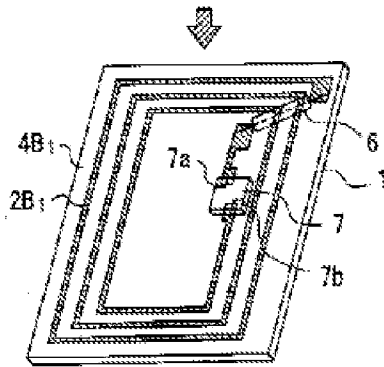
15. Claims 10, 18, 21 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to W. David Coleman whose telephone number is 571-272-1856. The examiner can normally be reached on Monday-Friday 9:00 AM - 5:30 PM.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Smith can be reached on 571-272-1907. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

W. David Coleman
Primary Examiner
Art Unit 2823

WDC
/W. David Coleman/
Primary Examiner, Art Unit 2823